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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,417	11/06/2000	Vance C. Bjorn	003022.P019X	9958

7590 06/13/2007	EXAMINER
Judith A. Szepesi	MOORTHY, ARAVIND K
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP	

ART UNIT	PAPER NUMBER
2131	

Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

MAIL DATE	DELIVERY MODE
06/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>07 February 2007</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-31</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-31</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>06 November 2000</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the appeal brief filed on 7 February 2007.

2. Claims 1-31 are pending in the application.

3. Claims 1-31 have been rejected.

Response to Arguments

4.   In view of the appeal brief filed on 7 February 2007, PROSECUTION IS HEREBY

REOPENED. The rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following

two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37

CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an

appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee

can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have

been increased since they were previously paid, then appellant must pay the difference between

the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing

below:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.   Claims 1-13 and 17-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Independent claims 1 and 17 are directed towards a method of authenticating a client. The claim recites "receiving a record ID for a user, the record ID being a random number generated for tracking authentication data and disassociating the authentication data from other client data". Claim 1 further recites "determining if the user's authentication data matches the record ID".

Page 12 (lines 7-15) of the specification of the current application states, "The authentication server 220 further includes a biometric data comparison logic 485, which compares the biometric data received from the client 240 with the biometric data associated with the particular user. For one embodiment, the user is identified based on the record ID. For one embodiment, the biometric data comparison logic 485 compares two templates. For another embodiment, the biometric data comparison logic 485 further includes a feature extraction logic 470, which generates a template from an image. For yet another embodiment, the template stored

in the authentication server 220 may be directly compared with the image received from the client 240".

The applicant describes how a user is authenticated by the use of biometric data and on a record ID. However, the applicant does not describe the record ID being a random number. Also, the applicant does not describe determining if the user's authentication data matches a record ID (random number). The applicant has not shown how a biometric can be authenticated with a random value. One of ordinary skill in the art would not be able to determine how a biometric feature can be authenticated with a random number.

6. Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 1 and 14 recite the limitation "the user's private key" in the claim. There is insufficient antecedent basis for this limitation in the claim.

8. Independent claims 1 and 17 recites "receiving a record ID for a user, the record ID being a random number generated for tracking authentication data and disassociating the authentication data from other client data". Claim 1 further recites, "determining if the user's authentication .data matches the record ID". However, as discussed above, it is unclear to the examiner how a record ID being a random number can be authenticated with the user authentication data.

9. Claim 2 recites the limitation "the private key" in the claim. There is insufficient antecedent basis for this limitation in the claim.

10. Claims 17, 19, 20 and 27 recite the limitation "the client" in the claim. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 19 recites the limitation "a nonce generation logic to generate a nonce, the nonce to be included with the user authentication data from the client". However, it is unclear how the nonce gets to the client. It is unclear to the examiner where the nonce is being generated.

12.   Claims 23 and 27 recite the limitation "the server" in the claim. There is insufficient antecedent basis for this limitation in the claim. It is unclear to the examiner whether it's the authentication server or the third-party server.

13.   Claim 24 recites the limitation "the client's authentication data" in the claim. There is insufficient antecedent basis for this limitation in the claim.

Any claims not directly addressed are rejected on the virtue of their dependency.

Claim Objections

14. Claims 14 and 17 are objected to because of the following informalities: grammatical errors.

As to claim 14, in the second limitation, the claim recites "generating one-time key and encrypting the one-time key with a public key of the user, and sending the encrypted one-time key and the record ID to the user". The examiner asserts that the word "a" has been omitted from the limitation. The limitation should recited "generating **a** one-time key and encrypting the one-time key with a public key of the user, and sending the encrypted one-time key and the record ID to the user". Independent claim 17 recites in the preamble "A third-party authentication system comprising". The preamble should recite, "A **three**-party authentication system comprising".

Appropriate correction is required.

Allowable Subject Matter

15. Claims 1-31 are allowed.

As to independent claim 1, prior art does not disclose, suggest or fairly suggest receiving a record ID for a user, the record ID being a random number generated for tracking authentication data and disassociating the authentication data from other client identity data, and a one-time key generated by a third party server and encrypted with a user's public key by the server. Prior art does not disclose, suggest or fairly suggest determining if the user's authentication data matches the record ID.

As to independent claim 14, prior art does not disclose, suggest or fairly suggest looking up a record ID associated with the user, the record ID being a random number generated to track the user's authentication data and used to separate the user's other identity information from the authentication data. Prior art does not disclose, suggest or fairly suggest generating a one-time key and encrypting the one-time key with a public key of the user, and sending the encrypted one-time key and the record ID to the user. Prior art does not disclose, suggest or fairly suggest receiving the authentication data, the authentication data being the decrypted one-time key decrypted with the user's private key by the authentication server, such that the user does not have control of the user's private key at any time. Prior art does not disclose, suggest or fairly suggest permitting access to the server.

As to independent claim 17, prior art does not disclose, suggest or fairly suggest an authentication server to receive a record ID for a user, the record ID being a randomly generated number used to separate the user's other identity information from the user's authentication data, and a one-time key generated by a third party server and encrypted with a user's public key by

the third party server. Prior art does not disclose, suggest or fairly suggest a comparison logic in

the authentication server to receive the user authentication data from the client and determine

whether the user's authentication data matches the record ID. Prior art does not disclose, suggest

or fairly suggest a decryption logic in the authentication server to decrypt the one-time key with

a private key associated with the validated record ID, and to return the decrypted one-time key to

the client, as discussed above.

Any claims not directly addressed are allowed on their virtue of dependency.

Conclusion

16.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aravind K Moorthy
June 7, 2007

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